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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/645,720  | 08/20/2003  | Steven R. Mead       | 1-29092             | 8169             |
| 4859 7590 03/15/2010<br>MACMILLAN SOBANSKI & TODD, LLC<br>ONE MARITIME PLAZA FIFTH FLOOR<br>720 WATER STREET<br>TOLEDO, OH 43604-1619 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| LAUX, JESSICA L   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 3635  |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/645,720

**Applicant(s)**

MEAD, STEVEN R.

**Examiner**

JESSICA LAUX

**Art Unit**

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 19-32, 34-40 and 42-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19-32, 34-40, 42-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notes of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 10/15/2009 have been fully considered but they are not persuasive.

In response to applicant's argument that Bainbridge is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Bainbridge is reasonably pertinent to the particular problem with which applicant was concerned, namely a padding layer of closed-cell foam material. Additionally it is noted that Bainbridge discloses that the foamed padding may be useful in any of various applications where foam padding is typically employed (Col. 9, lines 60-67); while Bainbridge does provide a listing of suitable uses, such listing is not presented as an exhaustive list, but merely a suggestive list of applications. It is well known and notoriously common to employ foam padding in a flooring installation, and therefore a flooring installation would be considered as a suitable use for foam and particularly the foam as disclosed by Bainbridge. Further US PG Publication 20040069924 discloses that it is known to employ padding typically used in sports equipment (paragraph 0007) as an underlayment in flooring. Therefore in view of the disclosures of Bainbridge and 20040069924 one of ordinary skill in the art would have had good and sufficient reason and motivation to look to the disclosure of Bainbridge to solve the particular problem

with which applicant was concerned. Lastly, Finley and 20040069924 both disclose having a foam padding in flooring installations for providing properties such as: shock absorption, durability, energy dissipation, return upon contact, and porosity among others. Bainbridge and other foams used in sports equipment look to provide padding having similar characteristics and there for that reason one of ordinary skill in the art would be motivated to look to Bainbridge for a foam padding.

Applicant's argument that that the rejection rationale has no basis in fact is not persuasive as the rationale clearly is drawn from the teachings of the prior art and that which is known and would easily be employed through common sense. Applicant has not clearly explained how the rationale is not based on fact and instead merely makes a bald assertion that itself is not supported by fact or evidence. Therefore, the argument is not persuasive.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-12, 19-32,34-38,42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finley (5578363) in view of Bainbridge (6453477) with reference to US PG Publication 20040069924.**

Regarding claims 1 and 19-20, 31-32, 45: Finley discloses a multi-layered flooring composite for use over a subfloor layer, said composite including a substantially horizontal top floor layer of substantially hard material (7), a subfloor layer of substantially hard material (6) and at least one acoustic layer (1) positioned between said top floor layer and said subfloor layer (where said layer includes a foam layer, abstract).

Finley does not expressly disclose the characteristics of the foam layer. Bainbridge discloses a closed cell foamed material of Polypropylene, having a plurality of discrete beads of substantially elastic, resilient material, wherein portions of adjacent beads abut one another and other portions of adjacent beads are spaced from each to create spaces therebetween that permit the flow of liquid through the acoustic layer, and wherein substantially all of said adjacent beads are integral joined together at the abutting portions thereof (Bainbridge - Col. 5).

It would have been obvious at the time the invention was made to modify the flooring and foam of Finley to be the foam material as disclosed by Bainbridge to provide a flooring surface that is resilient and durable for such activities as sports. (Reference US PG Publication 20040069924 which teaches using foams from sports padding as use in a flooring underlayment to make them suitable for cushioning and absorbing impacts due to sports while maintaining playability). Additionally it is noted that Bainbridge discloses In Col. 9, lines 60-67 using the padding material for use in other areas where padding is used (such as flooring).

Regarding claims 2-12, 22-23, and 35-38: The limitations of claims relating to the shape and location (including spaces) of the beads are merely limitations inherent to any of the various designs and constructions of a closed cell foam, as already known in the art and as disclosed by Bainbridge Cols. 2-5, 9.

Regarding claim 21: Finley in view of Bainbridge disclose the flooring composite as above, but do not expressly disclose the density of the acoustic layer, but do disclose various embodiments of fill percentages (equating to a density of the acoustic layer). It would have been obvious to one of ordinary skill in the art at the time the invention was made modify the density of the acoustic layer to be between 2-10 pounds per cubic foot as such a modification fails to provide an advantage, or solve a stated problem. Furthermore one of ordinary skill in the art would be motivated to pursue known options (such as various densities) to achieve a desired result (such as a certain amount of acoustic absorption) for the intended purpose of the invention.

Regarding claims 24-26: Finley in view of Bainbridge disclose the flooring composite as above where the projected diameters are greater than 1/8 inch, the same, or 1/4 inch (Bainbridge - Col. 5, lines 1-15), but do not expressly that the thickness is 1/8 inch. However, applicant has not disclosed that the claimed thickness provides an advantage, solve a problem, or are for a particular purpose. Therefore it appears to be a mere matter of design choice to one of ordinary skill in the art to use a closed foam having the claimed thickness as one would expect applicant's invention and that of Finley in view of Bainbridge to perform the same function of sound attenuation equally

well considering the properties of a closed foam. Therefor absent and criticality the claimed limitations are anticipated by the prior art.

Regarding claims 27-29, 42-44: Finley in view of Bainbridge disclose the claimed flooring composite as above, but do not expressly disclose the claimed percentages of beads and air spaces. However applicant has not disclosed that the claimed percentages provide an advantage or are for a particular purpose; furthermore the percentages appear to be obvious design choices for closed cell foams and one of ordinary skill in the art would be motivated to use any closed cell foam containing the various percentages as such a foam would provide the function of sound attenuation equally well consider the properties of a closed cell foam and specifically that as disclosed by Bainbridge Cols. 2-5,9.

Regarding claims 30, 34: The flooring composite of claim 1, wherein said acoustic layer further includes a plurality of inelastic beads mixed with said elastic beads with portion of some of the elastic beads abutting portions of adjacent inelastic beads and being integrally joined thereto (Bainbridge – Col. 9, lines 45-50).

**Claims 13-16,39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finley (5578363) in view of Bainbridge (6453477) with reference to US PG Publication 20040069924 and further in view of Fiechtl (6189279).**

Regarding claims 13-16, 39-40: Finley in view of Bainbridge discloses the flooring composite as above, but does not disclose a moisture-proof film. Fiechtl discloses a floor system having a foam sound insulating layer and further including a

moisture-proof film layer (18), where the layer is attached to at least some of the beads as it is attached to the foam comprised of the those beads.

The claimed limitations regarding the location of the film layer being between the acoustic layer and the subfloor or above the acoustic layer appear to be mere a mere design choice as applicant has not disclosed that either position provides an advantage, solves a stated problem or is used for a particular purpose, but rather discloses either position be an acceptable position. Therefore absent a showing of criticality, the limitations is anticipated by the prior art as disclosed above.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA LAUX whose telephone number is (571)272-



8228. The examiner can normally be reached on Monday thru Thursday, 9:00am to 5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./  
Supervisory Patent Examiner, Art Unit 3635

/J. L./  
Examiner, Art Unit 3635